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Serial No.: 08/479,995  
Filed: June 7, 1995  
Page 31 [(Amendment Under 37 C.F.R. §1.115  
(In Response To The October 27, 1999 Office Action) - August 25, 1999]

#### REMARKS

Reconsideration of this application is respectfully requested.

Claims 283-362, 364-380, 382-398, 400-404, 406-439 and 441-505 were previously pending in this application. Claims 283-294, 360-361, 411-417, 464-475 and 479-485 have been amended. No claims have been added or canceled by this paper. Accordingly, 283-362, 364-380, 382-398, 400-404, 406-439 and 441-505 as amended hereinabove are presented for further examination on the merits.

Before discussing the above changes to the claims and addressing the sole issue in the October 27, 1998 Office Action, Applicants acknowledge, with appreciation, the indication that the finality of the previous June 22, 1998 Office Action has been withdrawn pursuant to 37 C.F.R. §1.129(a). Applicants also acknowledge, with appreciation, that the previous rejection of claims 312, 318 and 330 as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn.

In a sincere effort to advance prosecution, Applicants have amended forty (40) claims by defining the signalling entity or entities to be -- non-radioactive -- . Previously, in several of these amended claims, the signal generating portion(s) were defined to be "non-radioactive." The claims affected by these changes include:

claims 283-294, 464-475 (composition of matter);  
claims 360 & 361 (article of manufacture); and  
claims 411-417 & 479-485 (kit).

It is believed that the foregoing amendments patentably distinguish Applicants' claimed invention over the prior art cited of record. Entry of the above amendments to the claims is respectfully requested.

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**The Rejection Under 35 U.S.C. §102**

Claims 283-296, 298-301, 304, 306, 307, 309-321, 323-333, 335-340, 343-347, 350, 353, 358-362, 411-419, 422, 423, 426, 427, 434-438, 441, 461-475, and 488-505 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by Dunn et al., ["A Novel Method to Map Transcripts: Evidence for Homology between an Adenovirus mRNA and Discrete Multiple Regions of the Viral Genome," Cell 12:23-36 (1977)]. In the Office Action (pages 2-4), the Examiner stated:

This rejection is maintained and reiterated from the previous office action, mailed 6/22/98, regarding the instant composition and kit claims and added against the newly added claims for reasons given as follows. It is noted that applicants have amended claims such as 283 to require that the second part of the claimed composition of matter contains "one or more non-radioactive signal generating portions". It is noted that the second part is not limited to being fully non-radioactive but rather only "portions" thereof. It is also noted that radioactive labeling as practiced in Dunn et al. also does not result in every nucleotide being P<sup>32</sup> labeled in the signalling segments therein disclosed. Such non-radioactive portions also are capable of hybridizing to nucleic acid segments themselves with signalling entities thereon. It is again noted from previous office actions that compositions or kits are rejected in the above cited instant claims and that inherent capabilities, that are also present in a reference such as Dunn et al., or the novel "naming" of various segments do not confer patentable weight. Thus, the Dunn et al. second part also contains "non-radioactive portions" and therefore are "second parts" such as cited within instant claims 283 etc. Now applicants' arguments will be responded to. Applicants argue that the newly added claims are based on claims only previously objected to as depending from rejected claims in order to submit them in independent form. One such previously objected to claim is 297 on which these new claims are based. It is noted that claim 297 is limited to bacterium or bacterial component practice but claim 464, for example, is not limited as such but rather includes viral components in line 6 which is deemed to include viral polynucleotide segments. Claim 302 is also cited as being the basis for newly added claims. Claim 302 is directed to antigen or antibody practice but newly added claim 464, for example, includes much more than antigen or antibody practice such as a polynucleotide sequences in the last three lines therein. Thus, many of the newly added claims are included herein due to the breadth of claims that have been newly submitted and not limited to limitations only from previously objected to claims. The newly added kit claims 488-505 still only contain components as previously rejected in composition or kit claims and are therefore rejected hereinunder. Applicants also argue that P<sup>32</sup> labeling is not artificial alteration. This

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is non-persuasive because such a label is clearly artificial and clearly an alteration from an unlabeled oligo- or polynucleotide.

The anticipation rejection is respectfully traversed.

As indicated in the opening remarks of this Amendment, claims 283-294, 360-361, 411-417, 464-475 and 479-485 have been amended to recite non-radioactive signalling entities. It is believed that the new claim language, which has been incorporated into all of the previously rejected independent claims, negates the issue of novelty posed by Dunn's 1977 Cell paper (as well as their 1978 Cell publication).

#### **Otherwise Allowable Claims**

Claims 297, 302, 303, 305, 308, 322, 334, 341, 342, 348, 349, 351, 352, 354-357, 420, 421, 424, 425, 428-433, and 476-478 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Pending resolution of the prior art issue, Applicants respectfully request that these claims be held in abeyance until such time as the prior art issue is satisfactorily resolved.

#### **Allowed Claims**

Applicants sincerely appreciate the indication that a number of claims are allowed. In addition to those claims previously indicated in the June 22, 1998 Office Action as being allowed, claims 479-487 have also been allowed in the October 27, 1998 Office Action.

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Favorable action on the claims as amended above is respectfully requested.

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#### SUMMARY AND CONCLUSIONS


Claims 283-362, 364-380, 382-398, 400-404, 406-439 and 441-505 are presented for further examination on the merits. Claims 283-294, 360-361, 411-417, 464-475 and 479-485 have been amended above. No claims have been added or canceled. No new matter has been inserted by any of the foregoing amendments to the claims.

Concurrently being filed with this Amendment is Applicants' Petition To Revive An Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) and authorization for the large entity therefor. No other fee or fees are believed due in connection with this Amendment or the concurrently filed Petition. In the event that any fee or fees are due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such other fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

If it would be helpful to expediting the prosecution of this application, the undersigned may be contacted by telephone at 212-583-0100 during the daytime business hours.

Early and favorable action on this application is respectfully sought.

Respectfully submitted



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